

REMARKS

Original claims 1 – 36 are pending. No new matter has been introduced by this amendment into the specification and/or claims.

The present amendment is based on the decision and guidelines offered in the Decision on Request For Rehearing rendered on September 29, 2009 by the Board of Patent Appeals and Interferences, which rejected the claims on different grounds than those advanced by the Examiner. Based on the Board's decision and rationale Applicant submits that the present case should be in condition for allowance.

The rejections are addressed through a combination of traverse, amendment and argument as noted below. Briefly:

- The single prior art § 103 rejection based on Hastings et al (6584450) taken with Ostrom (and other official notices) is also addressed through specific amendments and arguments which clearly define patentable subject matter over any such teachings provided by such combination.

Reconsideration and favorable action is thus requested.

Rejection under §103 – Claims 1 - 34

The Board's decision states that the rejection was upheld because the language of claim 1:

"....does not require that the list always include at least one playable media, as asserted by the Appellant because the claim language is conditional upon a confirming response back from the subscriber as to whether to include the media or not."

See Decision of September 29, page 3. To remedy this concern by the Board, the Applicant has specifically amended the claim to recite that the steps are repeated as needed when an automatic refill option is enabled so that the subscriber delivery queue does indeed include at least one playable media item that is accepted for delivery by such subscriber. In other words, the list does always include at least one item, by confirmation of the subscriber, which could of course be explicit or implicit (i.e., based on a passage of time or some other factor as noted in the specification).

Claim 1 has also been amended slightly to make the terminology more consistent with the specification and other claims. Consequently Applicant submits that the claim as amended should be allowable.¹

Dependent claims 2 – 34

The dependent claims should be allowable for at least the same reasons as above. Moreover, these claims should be allowable for the additional reasons set forth previously; should further discussion be needed, Applicant will re-argue these as necessary.

Claim 35: this claim has been amended similarly to claim 1 and should be allowable for the same reasons. Moreover this claim states that the monitoring is done automatically and includes "... analyzing the content and/or characteristics of other playable media items within said subscriber selection queue..." to determine what changes should be made, if any to the same. This limitation is also not taught or suggested in the prior art, and is yet another reason why this claim should be allowed.

Claim 36 has been amended as well and should be allowable for substantially the same reasons articulated above.

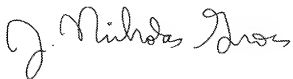
Conclusion

The Applicant has fully addressed all the outstanding rejections, and submits that the above should place the present case in condition for allowance.

¹ Applicant nonetheless disagrees with the Board's new and different interpretation of the "Max Turns" feature of the Hastings reference, and reserves the right to challenge the same should it become necessary in the present proceedings or elsewhere.

Should the Examiner wish to discuss anything related to this case in person, feel free to contact the undersigned at any convenient time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Nicholas Gross". The signature is fluid and cursive, with the first name "J." being small and the last name "Gross" being larger and more prominent.

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